

REMARKS

This Amendment is submitted in response to the Office Action dated November 29, 2004. In the Office Action, the Patent Office rejected Claims 1-3, 8, 9, and 11 under 35 U.S.C. §103(a) as being unpatentable over *Walz* (U.S. Patent No. 5,664,725) in view of *Schwan et al.* (U.S. Patent No. 5,524,934). Further, the Patent Office rejected Claim 7 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and further in view of *Fabel* (U.S. Patent No. 5,836,622). Moreover, the Patent Office rejected Claims 4-6, 10, 12 and 24-26 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and further in view of *Petkovsek* (U.S. Patent No. 5,697,648). Applicant notes with appreciation that the Patent Office indicated that Claims 13-23 are in allowable form.

By the present amendment, Applicant amended Claims 1, 4, 5, 9, 11, and 24-26. Applicant submits that the amendments to the claims, in view of the foregoing remarks, overcome the rejections made by the Patent Office and place the application in condition for allowance. Notice to that effect is respectfully requested.

With respect to the rejection of Claims 1-3, 8, 9 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.*, Applicant submits that this rejection has been overcome in view of the foregoing amendments and the remarks that follow.

In the Office Action, the Patent Office alleges:

Walz discloses... a mailing assembly and a method of preparing a mailpiece comprising a label... wherein the label (10) includes a single-layered postcard... an integrally formed designator section... a first and second anchor portion... and a backing strip... wherein the backside includes indicia (Col. 4, lines 40-58).

However, Walz does not disclose: a designator section indicative of a special service; and a label including shading and printing wherein the shading and printing are a single color.

Schwan et al. discloses... a record in the form of a label... having selected portions for forming areas of a plurality of different colors, wherein coatings of colorless color formers and developers are initially combined (upon application of an imaging force) to form colored visible areas (Fig. 3 and 4).

Further, the Patent Office asserts that:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's label to include a label having self contained ink coatings to form a shading and printing of a particular color as set forth by Schwan et al...

As set forth above, independent Claim 1, as amended, defines a special service mailing assembly having a label that includes a return postcard defined by a periphery and having a designator section indicative of a special service. The designator section and the return postcard are printed with the same article identification number. Further, independent Claim 1, as amended, requires the label that includes shading of a first color and printing of the same color as the first color wherein the first color is indicative of the special service.

Independent Claim 9, as amended, defines a method for preparing a mailpiece for delivery by one of a plurality of special services and requires the step of providing a label a return

postcard integrally formed with a designator section indicative of one of the plurality of special services. A front side of the label includes shading of a first color and printing of the same color as the first color wherein the first color is indicative of one of the plurality of special services. Further, independent Claim 9, as amended, requires the step of providing at least one anchor portion indicative of one of the plurality of special services.

Walz merely teaches a multi-part mailing form having two superimposed sheets of material wherein detachable areas of the upper sheet are detached and secured to an item to be mailed, and sections of the sheets are separable from one another. Further, *Walz* merely teaches a return receipt with two side portions outside the area that are not adhered together. As admitted by the Patent Office, *Walz* does not disclose a designator section indicative of a special service and a label including shading and printing wherein the shading and printing are a same color.

Schwan et al. merely teach a sheet containing surface coatings of selected color formers and color developers which, when subjected to heat or pressure, combine to form different colored areas on the sheet. Further, *Schwan et al.* merely teach that "the coating may be applied in selected areas which can form blocks of background color, or they may be applied so as to form images,

symbols, stripes, borders, and the like." (See *Schwan et al.*, column 4, lines 57-60.)

Neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label having a return postcard defined by a periphery that has a designator section indicative of a special service, as required by independent Claim 1, as amended. Further, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a designator section and return postcard that are printed with the same article identification number, as required by independent Claim 1, as amended. Still further, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label that includes shading of a first color and printing of the same color as the first color wherein the first color is indicative of the special service, as required by independent Claim 1, as amended.

Moreover, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of providing a label having a return postcard integrally formed with a designator section indicative of one of the plurality of special services, as required by independent Claim 9, as required. Further, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of providing a label with a front side that includes shading of a first color and printing of the same color as the first color wherein the first color is indicative of one of the plurality of

special services, as required by independent Claim 9, as amended. Still further, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of providing at least one anchor portion indicative of one of the plurality of special services, as required by independent Claim 9, as amended.

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Walz* with *Schwan et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning*

Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Walz* and *Schwan et al.* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Walz* with *Schwan et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel features and the novel steps positively recited in independent Claims 1 and 9, respectively. Namely, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a return postcard and a designator section that have the same article identification number, as required by independent Claim 1, as amended. Moreover, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest a label that includes shading of a first color and printing of the same color as the first color wherein the first color is indicative of the special service, as required by independent Claim 1, as amended.

Moreover, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of providing a label that

has shading of a first color and printing of the same color as the first color wherein the first color is indicative of one of the plurality of special services, as required by independent Claim 9, as amended. Moreover, neither *Walz* nor *Schwan et al.*, taken singly or in combination, teach or suggest the step of providing at least one anchor portion indicative one of the plurality of special services, as required by independent Claim 9, as amended.

Accordingly, the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claim 7 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and further in view of *Fabel*, Applicant respectfully submits that the rejection has been overcome by the amendment to independent Claim 1 and for the reasons that follow.

In the Office Action, the Patent Office alleges:

Fabel discloses... the designator section (158) [that] has a machine readable code area. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Walz's* and *Schwan et al's* mailing assembly with a designator section having a machine readable code as taught by *Fabel* for the purpose of providing additional identifying information.

Claim 7 requires a special service mailing assembly having an area within the designator section that has a machine readable code.

Contrary to the assertions of the Patent Office, none of *Walz*, *Schwan et al.* nor *Fabel* teach or suggest that which is required by Claim 7. The Patent Office acknowledges that "*Walz* does not disclose wherein the designator section has a machine readable code". *Fabel* merely suggests that "the identifying number, which is placed in [the] left margin of the sender's receipt section... is also printed in block 158, oriented to be readable when upper edge 108 of form 72 is held upward". None of *Walz*, *Schwan et al.* nor *Fabel*, taken singly or in combination, teach or suggest a special service mailing assembly having an area within the designator section that has a machine readable code, as required by Claim 7.

Accordingly, the rejection of Claim 7 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 4-6, 10, 12 and 24-26 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and further in view of *Petkovsek*, Applicant respectfully submits that the rejection of Claims 4-6 has been overcome by the amendment to independent Claim 1; and that the rejection of Claims 10 and 12 has been overcome by the amendment to independent Claim 9. Further, Applicant submits that the rejection of independent Claims 24-26 has been overcome for the reasons that follow.

In the Office Action, the Patent Office alleges:

Walz as modified *Schwan et al.* discloses a mailing assembly and method of preparing a mailpiece comprising all the elements as set forth in Claims 1 and 9, and as set forth above...

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Walz's* and *Schwan et al.'s* mailing assembly with a printer track strip extension associated with the label as taught by *Petkovsek* for the purpose of allowing the mailing assembly to be passed through a printer.

Independent Claim 24, as amended, requires a label that has shading of a first color and printing of the same color as the first color and that has a single hole disposed therein. Independent Claim 25, as amended, requires a label that has a return postcard defined by a periphery and a designator section indicative of a special service. The designator section has an article identification number. Further, independent Claim 25, as amended, requires a label having shading of a first color and printing of the same color as the first color. Independent Claim 26, as amended, requires the steps of providing a label having shading of a first color and printing of the same color as the first color and providing at least one anchor portion has an article tracking number.

None of *Walz*, *Schwan et al.* or *Petkovsek*, taken singly or in combination, teach or suggest a label having shading and printing of a first color and a single hole disposed therein, as required by independent Claim 24, as amended. Further, none of *Walz*, *Schwan et al.* or *Petkovsek*, taken singly or in combination, teach or suggest

a label that has a designator section indicative of a special service that has an article identification number and a label that has shading and printing of a first color required by independent Claim 25, as amended. Still further, none of *Walz*, *Schwan et al.* or *Petkovsek*, taken singly or in combination, teach or suggest the steps of providing a label having shading and printing of a first color and providing at least one anchor portion that has an article tracking number as required by independent Claim 26, as amended.

As set forth above, the Patent Office admits that *Walz* does not disclose a label including shading and printing wherein the shading and printing are a same color. *Schwan et al.* merely teach that "the invention has the advantage that both information and the colored areas on the document may be achieved by printing in a single pass through a thermal or impact printer." (See *Schwan et al.*, column 7, lines 7-10.)

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Walz* with *Schwan et al.* and *Petkovsek* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Walz, Schwan et al.* and *Petkovsek* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Walz* with *Schwan et al.* and *Petkovsek* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

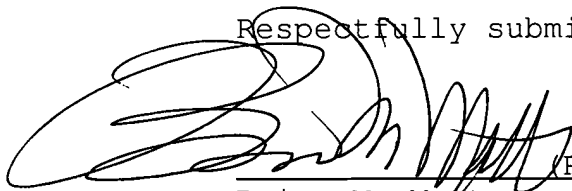
Accordingly, the rejection of Claims 4-6, 10, 12, and 24-26 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-8 depend from independent Claim 1; and Claims 10-12 depend from independent Claim 9. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements and novel steps of Applicant's novel assembly and method for preparing mailpieces, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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